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PATENT
Attorney Docket No. 020375-006500US

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Jeffrey G. Nowlin et al.

Application No.: 10/028,888

Filed: December 19, 2001

For: **WEIGHT MEASURING SYSTEMS
AND METHODS**

Examiner: Richard S. Woo

Art Unit: 3629

SUPPLEMENTAL APPELLANTS' BRIEF
UNDER 37 CFR §1.192 (a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants offer this Supplemental Brief in support of the Request for Reinstatement of Appeal submitted concurrently. This Brief is submitted in triplicate as required by 37 C.F.R. § 1.192(a).

REAL PARTY IN INTEREST

All right, title and interest in the subject invention and application are assigned to
First Data Corporation, 6200 South Quebec Street, Greenwood Village, CO 80111.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or are directly affected by, or have a bearing on the board decision of the pending appeal.

STATUS OF CLAIMS

Claims 1-26 were originally presented in the application. Claims 3, 5, 17, and 23 through 26 have been cancelled, and claims 27 through 35 have been added. Thus, claims 1, 2, 4, 6 through 16, 18 through 22, and 27 through 35 remain pending, and all such pending claims are rejected and are the subject of this appeal.

STATUS OF AMENDMENTS

An Amendment After Final Rejection (dated September 26, 2003) was filed, presenting arguments but making no amendments to the claims. Such Amendment After Final Rejection was considered by the Examiner, but was not deemed by the Examiner to put the application in condition for allowance.

In response to the Latest Office Action (dated May 4, 2004) reopening prosecution, Appellants have filed concurrently herewith an Amendment under 37 CFR 1.116, amending claims 1, 15, 18, 19, 27, and 31. Such amendments are believed to clearly overcome the new and additional rejection of those claims under 35 USC §112, and thus remove issues from appeal.

Appellants have attached two copies of claims to this Supplemental Brief:

Appendix A - all claims (1, 2, 4, 6-16, 18-22 and 27-35) pending as of the Latest Office Action, and assuming changes made by the concurrently filed Amendment under 37 CFR 1.116 are not entered.

Appendix B - all claims (1, 2, 4, 6-16, 18-22 and 27-35), assuming entry of the concurrently filed Amendment under 37 CFR 1.116. Since Appellants believe it is likely the rejection under 35 USC §112 has been overcome by the Amendment, it is likewise believed likely that the claims in Appendix B are those to be considered by the Board under this Appeal.

SUMMARY OF THE INVENTION

The present invention relates to a system and corresponding method for assembling and weighing a mailing unit formed from a plurality of components, such as mail

inserts and envelopes. In one embodiment, as represented by claim 1, the method includes determining and electronically storing the weight of each component in memory, and printing an identifier (e.g., bar code) on one of the components. The identifier is read in order to identify the components of the mailing unit and to place the inserts into the envelope. The total weight of the mailing unit is determined based on the individual component weights stored in memory. In an embodiment described in the specification at paragraphs 24 through 26, a system 100 and its corresponding method provide a printer 110 for printing the identifier on a component (such as card carrier) at the system (rather than being pre-printed elsewhere). The identifier is read at a reader (unit 116), and the system then assembles the components, places them in the envelope and determines the overall weight based on the printed identifier. As disclosed (paragraphs 24 through 26) and as recited in each of the claims, the identifier is printed on a component (e.g., card carrier) within the system 100 after such component is provided to the system 100. Such an arrangement provides readily appreciated advantages of flexibility to the system and method (e.g., not having to arrange pre-printing of the identifier on components, and being able to change the nature of the identifier at the system as circumstances dictate).

ISSUES

The rejection of the claims made in the Latest Office Action (May 5, 2004) are virtually identical to those in Final Office Action (August 12, 2003). Such rejections provide the basis for three issues on appeal:

- (1) Whether claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 20, 27, 30, 31 and 34 are anticipated under 35 U.S. 102(b) by **Long** (EP Publication No. 0,621,563)?
- (2) Whether claims 9, 11, 28, 29, 32, 33 and 35 are unpatentable under 35 U.S.C. 103(a) over **Long**?
- (3) Whether claims 13, 14, 21 and 22 are unpatentable under 35 U.S.C. 103(a) over **Long** in view of **Delfer** (U.S. Patent No. 5,264,665)?

Appellants point out that the basis for rejection of several dependent claims (claims 9, 11, 13, 14, 21, 28, 29, and 32 through 35) changed slightly from the Final Office Action to the Latest Office Action. The basis for rejection for most claims (including all the independent claims 1, 15, 27 and 31) has not changed.

For the convenience of the Examiner and the Board, Appellants have provided in Appendix C attached hereto a table showing for each claim on appeal the basis for rejection (under 35 USC §102 and §103) in both the Final Office Action (August 12, 2003) and the Latest Office Action (May 4, 2004). As can be seen in such table, the basis for rejection of claims 9, 11, 13, 14, 21, 28, 29, and 32 through 35 changed slightly, with the Examiner continuing to use the primary reference (**Long**) as the basis for rejection. Given this, and the fact that the rejection of the independent (and most dependent) claims is unchanged, Appellants believe the issues on appeal (and arguments in connection therewith) are essentially identical.

Further, as noted above the Examiner in the Latest Office Action did set forth a new and additional rejection of claims 1, 15, 18, 19, 27, and 31 under 35 USC §112. As to claims 1, 15, 27 and 31 (the independent claims in the application), the basis for such rejection was the recitation of the word "may" (stated by the Examiner as rendering the claims indefinite). As to claims 18 and 19, the basis for such rejection was the dependency of those claims from cancelled claim 17. By the Amendment filed concurrently herewith, the word "may" has been removed in claims 1, 15, 27 and 31, and claims 18 and 19 have been changed to now correctly depend from claim 15. Thus, Appellants believe the rejection under 35 USC §112 has been clearly overcome and such issue has thus been removed from appeal. Please note that the claims appearing in Appendix A do not reflect the proposed amendments to 1, 15, 18, 19, 27, and 31. The claims appearing in Appendix B do reflect the proposed amendments to 1, 15, 18, 19, 27 and 31.

GROUPING OF THE CLAIMS

For purposes of this appeal, all the pending claims, i.e. claims 1, 2, 6 through 16, 18 through 22, and 27 through 35, are considered by Appellant as a single group.

Appellant reserves the right outside the context of this appeal to argue independent patentability of the grouped claims.

ARGUMENT

Issue 1: Whether claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 20, 27, 30, 31 and 34 are anticipated under 35 U.S. 102(b) by **Long**?

Appellants believe that the subject matter of claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 20, 27, 30, 31 and 34 is not anticipated by **Long** as argued by the Examiner in the Final Office Action and in the latest Office Action.

Long discloses a mailing system where information is printed on a web of paper 14, after the web of paper is provided to the system. Such information (which the Examiner refers to as an "identifier") is name, address and other information printed on the web of paper 14 for purposes of producing a letter or similar insert (see, e.g., col. 6, lines 17 through 23 of **Long**).

As is well established, a claim is anticipated only when "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP Section 2131 and Verdegaal Bros. v. Union Oil Company of California, 814 F. E2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). In connection with the present claims, each of the independent claims 1, 15, 27 and 31 recite a novel combination of elements not disclosed in **Long**. For example, in claim 1, there is recited "printing at the system an identifier on one of the components forming the mailing unit *after that one of the components has been provided to the system*, wherein the identifier may be used *in identifying the components* of the mailing unit" and "reading the identifier to determine the components of the mailing unit" (emphasis added). Similar limitations appear in the other independent claims 15, 27, and 31.

The Examiner has apparently not fully considered such limitations in his arguments for rejecting the claims. For example, in the remarks to the Latest Office Action (page 3, concerning claim 1), the Examiner states that **Long** discloses "printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper" and "reading the identifier to determine the components of the mailing unit". Such a characterization of **Long** is not correct. The printed identifier or information in **Long** referenced by the Examiner is clearly not printed in order to later identify components of the mailing unit. Further, there is no step (or corresponding system elements) in **Long** for reading that identifier to determine the mailing components. To the contrary, the "identifier" (i.e., the information such as name and address) that is printed on the web of paper 14 in **Long** is solely for purposes of producing a letter or similar insert (see, e.g., col. 6, lines 17 through 23 of **Long**).

There is, in fact, an "identifier" in **Long** that is used to determine the components of the mailing unit. However, that identifier is the data record stored on each credit card 32, which identifier is necessarily printed (or stored) on the credit card before the card is provided to the system (in this connection, see col. 3, lines 5 through 8, and col. 5, lines 42 through 49 of **Long**).

Accordingly, **Long** does not show each and every element in the independent claims 1, 15, 27 and 31 (and the other rejected claims that are dependent therefrom), and thus such claims are not anticipated by **Long**.

Issue 2: Whether claims 9, 11, 28, 29, 32, 33 and 35 are unpatentable under 35 U.S.C. 103(a) over **Long**.

As to claims 9, 11, 29 and 33, the Examiner in the Latest Office Action asserts (remarks, page 8) that **Long** discloses the invention of the parent claims, "but does not expressly disclose the invention including that one of the inserts is a financial statement". The Examiner further asserts that this last mentioned limitation "is non-functional data and does not give any patentability weight to the claims", and therefore it would have been obvious to modify **Long** to obtain the invention" recited in these claims.

First, Appellants disagree that **Long** discloses the subject matter other than the limitation concerning the insert being a financial statement. As noted above, **Long** does not disclose significant limitations in the independent claims, for example the limitations in claim 1 of "printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier may be used in identifying the components of the mailing unit" and "reading the identifier to determine the components of the mailing unit".

Secondly, Appellants believe there is no basis for characterizing the limitations in question as having no "patentability weight". The term "financial statement" is in fact a functional limitation (it states the function of the insert). Furthermore, whether characterized as "functional" or otherwise, the recitation of "financial statement" is in fact a limitation that must be considered by the Examiner, and as such Appellants believe the burden is on the Examiners to show that such a limitation is taught or suggested by the prior art. It is well settled that all claim

limitations must be considered in determining obviousness. In re Miller, 418 F.2d 1392, 64 USPQ 46 (CIPA 1969); In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983); In re Jones v. Hardy, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984); In re Evanega, 829 F.2d 1110, 4 USPQ 2d 1249 (Fed. Cir. 1987).

As to claims 28, 32 and 35, the Examiner states (remarks, page 9) that it would have been obvious matter of design choice to modify **Long** to print an identifier on a card carrier (as opposed to the card itself). Such an analysis again ignores the specific recitation of Appellant's invention, namely that the identifier is printed on the carrier (insert) after such insert is provided to the system. As Appellants have explained, such a feature provides greater flexibility and convenience to the user of invention, since the identifier does not have to be pre-printed, and can be changed and re-designed as circumstances dictate.

Issue 3: Whether claims 13, 14, 21 and 22 are unpatentable under 35 U.S.C. 103(a) over **Long** in view of **Delfer**?

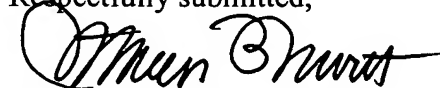
As to claims 13, 14, 21, and 22, the Examiner in the Latest Office Action asserts (remarks, page 10) that **Long** discloses the invention of the parent claims, "but does not expressly disclose the invention having the step of organizing, sorting or classifying the mailing units based on their weight within a given group via a marking".

Again, Appellants believe that Examiner mischaracterizes **Long**. **Long** does not disclose significant limitations in the independent claims, for example the limitations in claim 1 (parent claim of claims 13 and 14) of "printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier may be used in identifying the components of the mailing unit" and "reading the identifier to determine the components of the mailing unit". Thus **Long** is not properly combined with **Delfer** to teach or suggest the subject matter of claims 13 and 14, and the similar subject matter of claims 21 and 22.

CONCLUSION

It is believed that the above arguments as well as the concurrently filed Amendment are fully responsive to all grounds of rejection set forth in the Latest Office Action. It is further believed that no fee is required for filing the Request for Reinstatement of Appeal or this Supplemental Appellant Brief. Should the Patent and Trademark Office determine otherwise, however, please deduct the requisite fee from Deposit Account 20-1430.

Respectfully submitted,



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